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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,936	09/05/2003	Stephen Potts	1381-031188	8763
28289 7590 10/18/2007 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			EXAMINER A, PHI DIEU TRAN	
			ART UNIT 3633	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,936

Applicant(s)

POTTS, STEPHEN

Examiner

Phi D. A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what "IR" represents. It is thus confusing.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 22-25, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (5149027) in view of Snow (3583663).

Weber (figure 1) shows a clip comprising/consisting: a body having a first side and a second side; a flat portion (12) between the first side and the second side; a first prong member (14) projecting outward from the first side of the body; a second prong member (16) projecting outward from the second side of the body, with the first and second prong members bent transverse to the body in a first direction, the body, the flat portion, the first prong member and the second prong member being formed from a one piece blank member; wherein the first prong member and the second prong member are straight, unbent single-length single length members wherein the thickness of the flat portion, the single step portion, the first prong member and the

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second prong member (not including the barbs 22, 20, 28, 26) is uniform; wherein the first prong member and the second prong member consist of one flat plane; and wherein the planar width of the first prong member substantially along its length and the planar width of the second prong member substantially along its length are substantially less than the planar width of the flat portion and the single step portion, wherein the first prong member and the second prong member have a pointed end (18) and at least one barb(22, 20, 26,28) along the length of the first prong member and the second prong member, the clip is structured for use with sound absorbing media used with roof decks (inherently capable of being used as claimed), at least one barb along the IR length.

Weber does not show a step portion located on the flat portion, with portions of the flat portion located on opposite sides of the step portion, and the step portion is transverse to the body in a second direction of the body, the step portion, the first prong member and the second prong member being formed from a one piece blank member, wherein the step portion has an open faced recess projecting outwardly in the first direction.

Snow discloses the use of a step portion (11) to enable the clip to fasten conduits with large radius.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Weber's structure to show a step portion because it enables the clip to fasten conduits with large radius as taught by Snow.

Weber as modified shows a single step portion located on the flat portion, with portions of the flat portion located on opposite sides of the step portion, and the step portion is transverse to the body in a second direction of the body, the step portion, the first prong member and the

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second prong member being formed from a one piece blank member, wherein the step portion has an open faced recess projecting outwardly in the first direction, the portions of the flat portions located on opposite sides of the step portion having a smooth and continuous undersurface extending between the step portion and the first prong member and the step portion and the second prong member.

3. Claims 5, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (5149027) in view of Snow (3583663).

Weber as modified shows all the claimed limitations except for the step portion having a radius of .25-.5 inch.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Weber's modified structure to show the step portion having a radius of .25-.5 inch because having a radius of .25-.5 inch would enable the anchor to fasten to hangers of .25-.5 inch and .25-.5 inch.

4. Claims 6-7, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (5149027) in view of Snow (3583663).

Weber as modified shows all the claimed limitations except for the clip being metal material or polymeric material.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Weber's modified structure to show the clip being metal or polymeric material because metal, plastic are two well-known and cheap materials for forming clip device, and using any of these two well known and cheap materials to form the clip device would have been obvious to one having ordinary skill in the art.

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5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (5149027) in view of Snow (3583663).

Weber as modified shows all the claimed limitations except for the step portion having a radius of .25-.5 inch, the clip being metal.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Weber's modified structure to show the step portion having a radius of .25-.5 inch because having a radius of .25-.5 inch would enable the anchor to fasten to hangers of .25-.5 inch and .25-.5 inch, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Weber's modified structure to show the clip being metal because metal is a well-known and cheap materials for forming clip device, and using any of a well known and cheap materials to form the clip device would have been obvious to one having ordinary skill in the art.

Response to Arguments

1. Applicant's arguments with respect to claims 1, 4-7, 22-29 has been considered but is moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different clip device.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phi Dieu Tran A *PA*

10/14/07



RICHARD E. CHILCOT, JR.
SUPERVISOR PATENT EXAMINER